



PATENT
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

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3-21-01
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In re Application of:

Appeal No.

BONG-JIN-LEE *et al.*

Serial No.: 08/876,179

Examiner: GUSHI, ROSS

Filed: 13 June 1997

Art Unit: 2833

For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY
ASSEMBLY (as amended)

Attn: Board of Patent Appeals & Interferences

REPLY BRIEF

Assistant Commissioner
for Patents
Washington, D.C. 20231

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Pursuant to 37 C.F.R. §1.193(a) and (b), Appellant (hereinafter "Lee") hereby requests entry of this Reply Brief in reply to the Examiner's Answer (Paper No. 31). The Examiner's Answer was mailed 10 January 2001 in response to the Appeal Brief filed 23 October 2000.

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)), together with a written Request for An Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

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Date: 3/12/01

I.D.: REB/RHS/kf

REMARKS

Grouping of Claims

The Examiner's Answer correctly states that Lee's grouping of claims is inconsistent with the arguments that Lee makes. Accordingly, Lee respectfully requests that in its opinion the Board group the claims for its analysis in accordance with the arguments actually made in the Appeal Brief. In section VIII-A of the brief, Lee quotes and separately addresses the stated rationales for suggestion or motivation for claims 1, 18, 16, in that order.

Motivation

The Examiner's Answer (p. 7) now asserts for the first time that Yumibe “inherently” automatically engages the connector and contact per Lee's claim 1. For inherency to occur, a reference's device must necessarily and in all circumstances work the same way as the inventor's device. *Glaxo, Inc. v. Novopharm Ltd.*, 53 F.3d 1043, 34 USPQ2d 1565 (Fed. Cir. 1995). That it might sometimes work the same way is not sufficient.

It is “fundamental,” the Federal Circuit says, that a rejection based on inherency must be based on evidence of record. *In re Grasselli*, 713 F.2d 731, 739 (Fed. Cir. 1983). In that case, because “there is no evidence of record” of the

alleged inherent production of K2O, the Federal Circuit held that the obviousness rejection could not stand. *Id.* The court re-emphasized the point in that case, saying that if the feature “is inherent in the Japanese Patent, it has not been established by the record here and obviousness cannot be predicated on that which is unknown.” *Id.*

Where is the record evidence here for the new assertion of inherency? Where is the record evidence that Yumibe always automatically engages? The Examiner's Answer concedes that the reference does not even use the words (p. 7). How, then, is it supposed silently to teach an artisan of ordinary skill that combining Yumibe with other prior art will result in automatic engagement? As in *Grasselli*, this rejection is impermissibly “predicated on that which is unknown.”

Regarding claims 18 and 16, the Examiner's Answer states that the various contact shapes claimed are commonly used and the reasons for choosing one rather than another “were well known in the art” (p. 7). Where is the record evidence? *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000), requires the Examining Staff to provide substantial evidence of record to support factual assertions. Conjecture and bare assertion will not do.

Ordinary Skill

The Examiner's Answer denies (p. 7) that proper findings on ordinary level of skill are missing from the final rejection under appeal. But where are the “specific” findings that the Federal Circuit's decision in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), commands? Where in this record is there anything remotely resembling *Dembiczak*'s command that:

the Commissioner must . . . make specific findings of fact regarding the level of skill in the art (“a designer and manufacturer of trash and leaf bags, particularly one specializing in the ornamental and graphic design of such bags”), . . . [and] the relationship between the fields of conventional trash bags and children's crafts, respectively (“[t]he artisan would also have been well aware of the ancillary, corollary, and atypical uses of ‘trash’ bags such as their application in hobby and art projects”)

175 F.3d at 1000-01.

Furthermore, the Examiner's Answer does not even try to claim that the record contains substantial evidence as to level of skill or even a specific identification of the pertinent art in which level of skill is to be gauged. Yet, *Dembiczak* commands that, as well. See also, to the same effect, *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986) (“Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is

needed to show what that level of skill was.”).

Teaching Away

The Examiner's Answer (p. 7) seeks to avoid the flaw in its reliance on a reference that teaches away from the invention, by asserting that now “it is not clear at all what applicant in fact views as the ‘invention.’” Is this supposed to be a very belated § 112 ¶ 2 rejection? Is it sarcasm? Neither is appropriate in an Examiner's Answer or other PTO official action.

The answer to the supposed puzzle is found in the claims and specification. The invention is a hard disc drive in which a conventional connector apparatus is modified to provide a particular kind of coupling that eliminates the need for manual manipulation of parts that previously had to be manipulated when the unmodified prior art connector was used. This is in marked contrast to Yumibe, who teaches that you should use a novel connector structure because the prior art connector structure would not lead to success in accomplishing what the instant inventor sets out to accomplish.

The Examiner's Answer asserts (pp. 8-9), “Clearly, Yumibe does not teach away from using the Yumibe connector on known assemblies.” That completely misses the point. What Yumibe teaches away from is not using Yumibe's

connector; Yumibe teaches using Yumibe's novel connector. What Yumibe teaches away from is using the different connector that the instant inventor, Lee, uses. Lee's connector is a conventional connector of the type Yumibe says not to use, but Lee has supplied it with some additional (claimed) structural elements placed around it to make it do what Lee wants to accomplish. Yumibe says, Take the right fork in the road, don't take the left fork, because it won't work. Lee says, Oh no, take the left fork but change it a little in this way. The present facts thus show a classic case of teaching away.

Conclusion

The Examiner's Answer fails to rebut Lee's Appeal Brief. The final rejection below violates the commands of the Federal Circuit that specific findings must be made of a teaching, motivation, or suggestion in the prior art to justify the combination of references; and that the findings must be supported by substantial evidence of record. An independent ground of reversible error is that the final rejection violates the commands of the Federal Circuit that specific findings must be made as to the ordinary level of skill in the pertinent art, and the findings must be supported by substantial evidence. Finally, the principal reference teaches away from the invention. Any of these three independent grounds (or more, if you

treat lack of findings and lack of substantial record evidence separately) would suffice to make the rejection unsustainable. The Board should therefore, Lee respectfully submits, reverse the final rejections of all claims.

In view of the law and facts stated herein as well as all the foregoing reasons, Appellant believes that the rejection is improper and respectfully requests that the Board refuse to sustain the outstanding rejection of claims 1 through 8 and 9 through 18 under 35 U.S.C. §103.

A Request for Oral Hearing and an Appellants' check in the amount of \$270.00 drawn to the order of Commissioner accompany this Reply Brief. Should the check become lost, should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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Date: 3/12/10
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